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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,965	04/11/2001	Ihor W. Tarnawskyj	D/A0895Q	3831

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EXAMINER	
REDDICK, MARIE L	
ART UNIT	PAPER NUMBER
1713	10

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/833,965	TARNAWSKYJ ET AL.	
	Examiner	Art Unit	
	Judy M. Reddick	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04/15/03 & 05/08/03* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/08/03 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> *A person shall be entitled to a patent unless –*
>
> *(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

4. Claims 1, 3-6 and 9-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hiratsuka et al(U.S. 3,717,576).

Hiratsuka et al disclose resinous compositions defined basically as containing 10-35 pbw of a synthetic resin such as a phenolic resin, a vinylic resin, an epoxy resin, etc. and comfortably overlapping in scope with the claimed resin, 1-80 pbw of a finely divided graphite fluoride represented by the formula (CF)n wherein the molar ratio of C:F is 1:1 and comfortably overlapping in scope with the first carbon filler per the claimed invention and less than 80 pbw of other miscellaneous adjutants which include carbonaceous material such as artificial graphite, natural graphite, non-crystalline carbon, etc. and comfortably overlapping in scope with the second filler per the claimed invention. See, e.g., the Abstract and cols. 2-5. More specifically, Hiratsuka et al exemplify the following resinous composition: 50 g. of graphite fluoride (20 micron and less) and 1 kg. of novolak phenolic resin (non-volatile 75%) are agitated in the 3

1iter high speed agitator at 1000 r.p.m. for 30 minutes to produce a dispersion. Then, 3,950 g of artificial graphite powder (200 mesh and less) is mixed with the dispersion in the mixer at room temperature for 10 minutes. The composition of graphite fluoride, resin, and graphite powder thus produced has a specific gravity 1.84 and a Shore hardness 57. See Run 2 of Hiratsuka et al. Hiratsuka et al therefore anticipate the instantly claimed invention.

As to the crosslinking limitation per the claimed invention, it would be expected that the heated compositions of Hiratsuka et al would meet this limitation. As to the seam bonding property and volume resistivity per the claimed invention, it would be expected that the resinous compositions of Hiratsuka et al would necessarily possess these properties since the compositions are essentially the same as the claimed compositions as provided for under the guise of In re Best et al(195 USPQ 430).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

6. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. *Determining the scope and contents of the prior art.*
2. *Ascertaining the differences between the prior art and the claims at issue.*
3. *Resolving the level of ordinary skill in the pertinent art.*
4. *Considering objective evidence present in the application indicating obviousness or nonobviousness.*

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiratsuka et al(U.S. 3,717,576).

This disclosure of Hiratsuka et al for what it teaches as applied to claims 1, 3-6 and 9-16 and stated in the rejection supra. Further, the disclosure of Hiratsuka et al differs basically from the claimed invention as per the non-express disclosure of an embodiment directed to the use of a combination of a polyvinylbutyral resin and a phenolic resin(s). However, based on their equivalently taught scope at col. 3, lines 67-75, it would have been obvious to use a mixture of such and with a reasonable expectation of success, with the understanding that the "vinylic resin" is generic to the claimed "polyvinyl butyral resin" and necessarily implies that any vinyl resin including the claimed polyvinyl butyral resin would have been operable within the scope of patentees invention and with a reasonable expectation of success, absent a clear showing of unexpected results, commensurate in scope with the claims.

Claim Rejections - 35 USC § 102

9. Claims 1 and 3-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hasegawa et al(U.S. 4,141,849) or Helland et al(U.S. 4,681,830).

A) Hasegawa et al, as applied to claims 1 and 3-17, disclose and exemplify a developer comprising toner particles and finely divided graphite fluoride represented by the formula "(CFx)n and governed by a fluorine content falling within the scope of the claims wherein, the toner particles include a dye or pigment(carbon black) in a resin, as a binder which includes phenolic resin, epoxy resin, vinyl butyral resins etc. See, e.g., the Abstract, cols. 1-5, the Runs and claims of Hasegawa et al.

B) Helland et al, as applied to claims 1-6 and 9-16, disclose developer compositions defined basically as containing a thermoplastic binder such as Epoxy resins, polyvinyl butyral, etc., a magnetically responsive material, a fluorinated carbon material governed by a degree of fluorination of 10 to 100 wt.% and other additives such as carbon black, etc. See, e.g., the Abstract, cols. 1, 2, 4-6, Runs 1-3 and the claims of Helland et al.

Further, the graphite fluoride component of Hasegawa et al(col. 3, lines 29-57) and the fluorinated carbon component of Helland et al(Abstract and col. 4, lines 23+) clearly overlaps in scope with the claimed fluorinated carbon component. Further, Hasegawa et al teach phenolic resins in combination with polyacrylic acid resins & vinylbutyral polymers(col. 4, lines 11-25). As to the phenolic resins of Hasegawa et al, such are generic to the claimed phenolic resin(s) and necessarily implies that any phenolic resin(s), including the claimed phenolic acrylic resin per claim 8 would have been operable within the scope of patentees invention and with a reasonable expectation of success. In any event, the use of any commercial available phenolic resin in lieu of the disclosed phenolic resin of Hasegawa et al

would have been obvious to the skilled artisan and with a reasonable expectation of success. The carbon black component per each of Hasegawa et al and Helland et al is sufficient to meet the claimed secondary filler per claim 10. As to the crosslinking limitation per claim 9, it would be expected that the heated compositions of each of Hasegawa et al and Helland et al would meet this limitation. As to the volume resistivity per each of claims 14 and 15, it would be expected that the compositions of each of Hasegawa et al and Helland et al would necessarily possess this property since the compositions of each of Hasegawa et al and Helland et al are essentially the same as the claimed composition(In re Best et al, 195 USPQ 430). There is absolutely nothing on this record establishing that this, in fact, is not the case.

Each of Hasegawa et al and Helland et al therefore anticipate the instantly claimed invention. The claimed property as an adhesive, if not expressly taught per the disclosures of patentees, would be expected to be possessed by the compositions of each of patentees since the compositions of each of patentees are essentially the same as the claimed adhesive. Applicant has the burden to show that this, in fact, is not the case as provided under the auspices of In re Best et al(195 USPQ 430).

Response to Arguments

9. *Applicant's arguments filed 04/15/03 have been fully considered but they are not persuasive.*

Relative to Hasegawa et al and Helland et al—The crux of Counsel's arguments appear to hinge on the use of the compositions of Hasegawa et al or Helland et al as a seam binding adhesive not being taught nor suggested and to this end, Counsel is herein reminded that when the claimed compositions are not novel they are not rendered patentable by the recitation of properties, whether or not these properties are shown or suggested in the prior art. The bottom line is that there is nothing viable on this record showing that the compositions of both Hasegawa et al and Helland et al do not have seam bonding properties. Mere Counsel's arguments, unsupported by factual evidence, are given little weight as provided for under the guise of In re Lindner(173 USPQ 356).

Applicant is herein apprised that in the Final Office Action(paper no. 6, 03/13/03) @ paragraph no.5, claims 1 and 3-17 and not claims 1-17 should have been reflected in the claim header. However, it is clear from the cover letter(PTO FORM 326, item nos. 4 and 6) that this was an inadvertent error. An apology is extended for any inconvenience that this may have caused.

Conclusion

10. The prior art to Teeters et al is cited as of interest in teaching processes for producing fluorinated carbon compounds described in U.S. 3,717,576 to Hiratsuka et al and similar to those as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick

Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR
June 18, 2003